UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/350,144	07/09/1999	KAZUNORI TAKAHASHI	21.1935	7639

21171 7590 06/13/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
CHEVALIER, ROBERT	

ART UNIT	PAPER NUMBER
2616	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/350,144	TAKAHASHI, KAZUNORI	
	Examiner	Art Unit	
	Bob Chevalier	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,10-18 and 22-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1,3-6,13,15-18,25,27-29,31,32,37,38,40,41,46,47 and 49* is/are allowed.

6)☒ Claim(s) *2, 10-12, 14, 22- 24, 26, 30, 33-36, 39, 42-45, and 48,* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 July 1999* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2, 11-12, 14, 24, and 26, are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al (P.N. 5,627,655) as set forth in the previous Office Action mailed out on 10/22/2004.

3. Claims 10, 22-23, 33, and 42, are rejected under 35 U.S.C. 102(b) as being anticipated by the submitted prior art of Kitazawa Hiroaki (P.N. 09083920) as set forth in the previous Office Action mailed out on 10/22/04.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 30, 35-36, 39, 45, and 48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto et al in view of the admitted prior art, Figure 2, and described at pages 3-4, of the present Application, as set forth in the previous Office Action mailed out on 10/22/04.

6. Claims 34, and 43-44, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art Kitazawa Hiroaki (P.N. 09083920) in view of

the admitted prior art, Figure 2, and described at pages 3-4, of the present Application, as set forth in the previous Office Action mailed out on 10/22/2004.

7. Claims 1, 3-6, 13, 15-18, 25, 27-29, 31-32, 37-38, 40-41, 46-47, and 49 contain allowable subject matter over the prior art of record.

Response to Arguments

8. Applicant's arguments filed 2/22/05 have been fully considered but they are not persuasive.

Regarding the Applicant's argument in that the cited prior art of Okamoto et al fails to disclose the feature of storing information when a copy guard signal is detected, Examiner disagrees. It is noted that such a feature of "storing information when a copy guard signal is detected" as argued by Applicant is not recited in the claimed invention. Contrarily, the claimed invention only calls for "preventing from storing screen information digitized.... in the case where... the copy guard signal is detected". Therefore, as pointed out in the previous Office Action and also as admitted by Applicant on page 12 of his Remarks, Okamoto et al does disclose the feature of "preventing recording when copy guard signal is detected" recited in the claimed invention.

Applicant further argues that Examiner previously conceded in the Office Action of 10/22/03 that the cited reference of Okamoto et al fails to disclose the feature of "...preventing the video encoding circuit from outputting the video signal in the case where an output of screen information stored in the storage device is ordered, and in the case where the information is protected from copying".

It is to be noted that previously Examiner might have misread the reference or the claim. However, upon second review of the cited reference of Okamoto et al, it is clear that the cited reference of Okamoto et al does disclose such a feature as argued by Applicant. Applicant's attention is directed to the processing circuit shown in Okamoto et al's Figure 1, components 2-3, and further, see Okamoto et al's column 3, lines 22-25, where Okamoto et al discloses inhibition of recording operation in the case of detecting from the inputted video signal copy guard or information indicating copying prohibition or inhibition operation.

Regarding the Applicant's argument in that the cited reference of Kitazawa fails to teach the claimed feature of reducing the digitized screen information to deteriorate quality of an image in the case where the digitized screen information is protected from copying and that the cited reference only teaches a reproducing apparatus and that when a copy guard signal is detected printing out "characters to the recording part, Examiner disagrees. It is noted that as indicated in the previous Office Action the cited reference of Kitazawa does clearly disclose the feature of reducing the digitized screen information to deteriorate the quality of the image in the case where the digitized screen information is protected from being copying. Applicant's attention is directed to the capability of masking the video data or introducing noise to the video data before recording the same on the recording medium when the copyright protection signal is detected as indicated in Kitazawa's page 7.

Regarding the Applicant's argument in that there is no reasonable chance of success to combine the cited art of Okamoto in view of APA as indicated in the previous

Office Action, Examiner disagrees. It is noted that the proposed combination of Okamoto in view of APA indicated in the previous Office Action would have a reasonable chance of success since both references are directed to a video recording/reproducing apparatus and that one of ordinary skill in the art would have been motivated to combine the two references in the manner previously indicated, that is, to modify the inputting means provided in the cited reference of Okamoto et al's Figure 1, components 10, and 12, so as to have a display means connected thereof for the purpose of displaying inputted video data without deterioration on a screen of a display device regardless of whether copy guard signal is detected or not in the same conventional manner as is described in the admitted prior art described at Figure 2 of the present Application. The motivation is to be able to view the inputted video data on a display means at any desired time as suggested in the prior art.

Regarding the Applicant's argument in that there is no reasonable chance of success to combine the cited art of Kitazawa Hiroaki in view of APA as indicated in the previous Office Action, Examiner disagrees. It is noted that the proposed combination of Kitazawa Hiroaki in view of APA indicated in the previous Office Action would have a reasonable chance of success since both references are directed to a video recording/reproducing apparatus and that one of ordinary skill in the art would have been motivated to combine the two references in the manner previously indicated, that is, to modify the inputting means provided in the cited reference of Kitazawa's Figure 1, component 1, so as to have a display means connected thereof for the purpose of displaying inputted video data without deterioration on a screen of a display device

regardless of whether copy guard signal is detected or not in the same conventional manner as is described in the admitted prior art described at Figure 2 of the present Application. The motivation is to be able to view the inputted video data on a display means at any desired time as suggested in the prior art.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B. Chevalier
June 7, 2005.

ROBERT CHEVALIER
PRIMARY EXAMINER